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Attorney Docket No. LeA 34 992

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of Fahrig et al.,

Serial No.: 10/045,884

Group Art Unit: 1617

Filed: January 9, 2002

Examiner: Shengjun Wang

For: Use of Chromans

CERTIFICATION OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence and any papers referred to as attached are being deposited, on the date shown below, with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: November 12, 2003

*Susan M. Pellegrino*  
Susan M. Pellegrino

REPLY

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action mailed August 14, 2003 (Paper No. 10), Applicants respectfully request reconsideration and reexamination of the present application in view of the following amendments and remarks.

REMARKS

Claims 1 and 2 are pending in this application.

***Double Patenting Rejection***

The Examiner has rejected claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-5 of U.S. Patent No. 6,235,774 (Paper No. 10, page 2).

It remains unknown what subject matter claimed and disclosed in the present application will be deemed allowable; hence any statement regarding this rejection made on Applicants' part would be premature. Therefore, Applicants respectfully traverse this rejection, and request that this rejection should be held in abeyance until subject matter is deemed allowable in this application.

**Rejection Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 103(a) as unpatentable over Fahrig, et al., (WO 99/26621) (Paper No. 10, page 3). Applicants respectfully traverse.

The present invention relates to a method of treating Parkinson's disease comprising administration of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide.

In an MPTP animal model of Parkinson's disease, treatment with the compound of the present invention demonstrated a decrease in the degree of severity of the motor symptoms characteristic of Parkinson's disease (*see, e.g.*, page 6-7 of the specification). Specifically, the compound of the present invention produced a 22% reduction in motor symptoms as compared to control (*see, e.g.*, Table 1, page 7 of the specification).

Fahrig, et al., discloses a generic formula, but does not specifically suggest the use of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to treat Parkinson's disease. Fahrig, et al., describes that treatment with a test compound reduced the ischemic-induced GFAP immunoreactivity in a dose-dependent manner (*see, e.g.*, page 11 of the specification). However, there is no suggestion by Fahrig, et al., that treatment with 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide would produce a 22% reduction in motor symptoms characteristic of Parkinson's disease.

Thus, based on the disclosure of the prior art reference, one skilled in the art would not have been motivated to administer 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to alleviate the severity of the motor symptoms of Parkinson's disease.

In addition, one of ordinary skill in the art would not have a reasonable expectation of success, that is, treatment with 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide would produce a reduction in motor symptoms characteristic of Parkinson's disease relying on the disclosure by Fahrig, et al. As discussed above, Fahrig, et al., describes that treatment with a test compound reduced the ischemic-induced GFAP immunoreactivity. However, one skilled in the art would certainly not have a reasonable expectation that 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide would alleviate the severity of the motor symptoms based on Fahrig, et al.

It is therefore respectfully submitted that Fahrig, et al., fail to teach or suggest the methods as presently claimed, and that the current invention is novel and nonobvious in view of the prior art references. For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present rejection.

### CONCLUSION

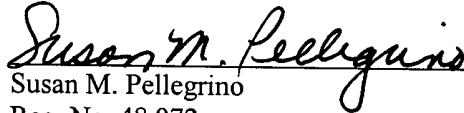
For the foregoing reasons, Applicants submit that the claims are in condition for allowance and Applicants respectfully request reexamination of the present application, and reconsideration and withdrawal of the present rejections. Should there be any further matter requiring consideration, Examiner Wang is invited to contact the undersigned counsel.

If there are any further fees due in connection with the filing of the present reply, please charge the fees to undersigned's Deposit Account No. 13-3372. If a fee is required for an extension of time not accounted for, such an extension is requested and the fee should also be charged to undersigned's deposit account.

November 12, 2003

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Respectfully submitted,

  
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